



#21
12/13/01
RECEIVED
NOV 20 2001
TECH CENTER 1600/2900

In re Patent Application of

KAWASHIMA et al.

Appln. No. 09/402,277

Filed: September 30, 1999

FOR: METHOD OF NUCLEIC ACID AMPLIFICATION

Atty. Ref.: 1430-269

Group Art Unit: 1655

Examiner: F. Lu

* * *

RESPONSE TO RESTRICTION REQUIREMENT

November 16, 2001

Hon. Commissioner for Patents
Washington, D.C. 20231

Sir:

Responsive to the Restriction Requirement (Paper No. 17) mailed August 30, 2001, entry and consideration of the following remarks are respectfully requested.

Claims 1-26 and 59-64 are pending. In response to the restriction requirement, Applicants elect Group I (claims 1-26) with traverse. Applicants reserve the right to prosecute the nonelected claims in a divisional application.

Notwithstanding the above election, Applicants disagree with the Examiner's contention that claims 1-26 and 59-64 lack unity of invention, and therefore fall into different groups of invention. Traversal is based on claims 1-26 and 59-64 being linked so as to form a single general inventive concept under PCT Rule 13.1. Therefore, Applicants request that claims 1-26 and 59-64 be examined together in this application.

Applicants submit that, in accordance with the M.P.E.P., the claims identified by the Examiner as Groups I and II are linked to form a single general inventive concept. In particular, the Examiner's attention is directed to M.P.E.P. § 1850 C. Combinations of Different Categories of Claims (8th Ed., August 2001) which states on page 1800-62:

The method for determining unity of invention under Rule 13 PCT shall be construed as permitting, in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(B) In addition to an independent claim for a given process, an independent claim for an apparatus or means specifically designed for carrying out the said process

Also an apparatus or means shall be considered to be specifically designed for carrying out a claimed process if the contribution over the prior art of the apparatus or means corresponds to the contribution the process makes over the prior art. Consequently, it would not be sufficient that the apparatus or means is merely capable of being used in carrying out the claimed process. However, the expression specifically designed does not imply that the apparatus or means could not be used for carrying out another process, nor that the process could not be carried out using an alternative apparatus or means.

Although the Examiner cites Adams et al. in support of his assertion that the claimed method and apparatus do not distinguish over the prior art, the only rejections against claims 1-26 and 59-64 were withdrawn in this Office Action. Thus, it would be premature at this time to find that the claims are not novel and nonobvious.

Upon an indication that the claimed method is allowable, Applicants submit that claims directed to the apparatus would have to be examined. Delaying the examination of claims 59-64 would not be in the public interest and does not result in compact prosecution. In particular, it is noted that the Examiner has already searched, examined, and issued an Office Action for the claimed method and apparatus. It does not constitute an undue burden to continue examination of claims 1-26 and 59-64 as amended.

Having fully responded to the pending objections and rejections in the Office Action, Applicants submit the claims are in condition for allowance and earnestly solicit an Notice to that effect. If any further information is needed, the Examiner is invited to contact the undersigned.

Respectfully submitted,

NIXON & VANDERHUYE P.C.

By:



Gary R. Tanigawa
Reg. No. 43180

1100 North Glebe Road, 8th Floor
Arlington, VA 22201-4714
Telephone: (703) 816-4000
Facsimile: (703) 816-4100